

**Notice of Allowability**

Application No.

08/889,355

Applicant(s)

ENGLER ET AL.

Examiner

Michael C. Wilson

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5-5-05.
2. ☒ The allowed claim(s) is/are 41,54 and 55.
3. ☒ The drawings filed on 08 July 1997 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

**MICHAEL WILSON**  
**PRIMARY EXAMINER**



### **REASONS FOR ALLOWANCE**

The following is an examiner's statement of reasons for allowance:

Claims 1-40, 42-53 and 56 have been canceled. Claims 41, 54 and 55 remain pending in the instant application.

The effective filing date of the claimed invention remains July 8, 1997.

### ***Election/Restrictions***

Claim 54 has been recombined with claims 41 and 55 in view of applicants' arguments. Applicants argue claim 54 names a compound that falls within the scope of the elected inventive group. The structure of 3'-N-gluconamidopropyl-3"-N-cholamidopropyl-N-cholamide is within the genus of compound originally claimed. It is readily apparent that the structure of "3'-N-gluconamidopropyl-3"-N-cholamidopropyl-N-cholamide" referred to on pg 31, line 2 (Example 12) is within the genus of claim 41 as originally claimed.

Claims 41, 54 and 55 are under consideration.

### ***Claim Rejections - 35 USC § 112***

#### ***New Matter***

The rejection of claims 41 and 55 under 35 U.S.C. 112, first paragraph, new matter regarding the structure of the cholic acid group as amended on 9-2-04 has been withdrawn in view of applicants arguments and Example 12. Claim 54 has support in Example 12.

### ***Written Description***

The rejection of claims 41 and 55 under 35 U.S.C. 112, first paragraph, written description regarding the structure of Impurity II and how the cholic acid group was attached to Formula I has been withdrawn in view of applicants' arguments and Example 12. Claim 54 was adequately described in Example 12.

### ***Enablement***

The rejection of claim 41 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention has been withdrawn in view of Example 12. Claims 54 and 55 are enabled in Example 12.

### ***Indefiniteness***

The rejection of claims 41 and 55 as being indefinite because the structures encompassed by the claims are unclear has been withdrawn in view of applicants' arguments. Claim 54 is definite because one of skill would have been able to determine the structure using the chemical steps of Example 12.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached at the office on Monday, Tuesday, Thursday and Friday from 9:30 am to 6:00 pm at 571-272-0738.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on 571-272-0735.

The official fax number for this Group is (571) 273-8300.

Michael C. Wilson

A handwritten signature in black ink, consisting of a series of vertical, wavy lines followed by a horizontal stroke.

**MICHAEL WILSON  
PRIMARY EXAMINER**